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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,746	05/26/2004	Michael P. Wenniger	FUNU 0102 PUSP	3745

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EXAMINER	
COE, SUSAN D	

ART UNIT	PAPER NUMBER
1655	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,746	WENNIGER, MICHAEL P.	
	Examiner	Art Unit	
	Susan D. Coe	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *8-14* is/are withdrawn from consideration.

5)☒ Claim(s) *15-19* is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed May 2, 2005, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.

2. Claims 15-19 have been added.

3. Claims 1-19 are pending.

4. In the reply filed on December 10, 2004, applicant elected with traverse Group I, claims 1-7 (now including claims 15-19).

5. Claims 8-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 10, 2004.

6. Claims 1-7 and 15-19 are examined on the merits.

Claim Rejections - 35 USC § 103

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,491,540 in view of WO 01/05356 and US Pat. No. 5,817,329 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that there is not proper motivation to combine the references together. Applicant argues that *In re Geiger* "contradicts the notion that motivation exists for combining components used individually for the same purpose." However, the examiner does not agree with applicant's interpretation of *Geiger*. There are two opinions in

Geiger establishing that the invention is not obvious over the prior art. The first opinion states that the invention is not obvious because the references contain statements that teach away from combining the individual ingredients together. The second opinion believes that there is sufficient motivation to combine the ingredients together but still feels that the invention is patentable over the prior art due to unexpected results. *Geiger* does not provide a blanket statement that there is no motivation to combine ingredients known in the prior art to be used individually for the same purpose. *Geiger* supports that the reasoning there is motivation to combine the ingredients unless the prior art references teach away from the combination or the applicant provides proof of unexpected results. In this current rejection, none of the references are considered teach away from the combination and applicant has not provided sufficient proof of unexpected results.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The rejection only takes into account what was known in the art. That all of the claimed ingredients are known to be useful in weight loss methods. Thus, the rejection is not based on improper hindsight reasoning.

Applicant also argues that the references require ingredients that are not claimed; thus, picking and choosing applicant's claimed ingredients from those in the prior art would also be

improper hindsight. However, applicant's claims use the broad transitional phrase "comprising." As discussed in MPEP section 2111.03, "The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps…". Thus, the references are still are considered to teach the stated claims because applicant's claims encompass unrecited elements. All of the ingredients taught by the references can be combined and the composition would still read on a composition "comprising" applicant's claimed ingredients.

Applicant also argues that the claimed invention is patentable over the prior art based on commercial success of the claimed invention. However, applicant has not met the criteria set forth in MPEP section 716.03 for providing sufficient support for a claim of nonobviousness based on commercial success.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

8. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,491,540, WO 01/05356 and US Pat. No. 5,817,329 as applied to claim 1 above, and further in view of US Pat. No. 5,968,544 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that US '544 should not be combined with the other references because the reference is directed towards using Vitamins B6 and B12 to increase weight gain. However, it is unclear where it is taught in the reference that the

composition is used for weight gain. The reference is directed to a composition that increases energy and allows for increased exercise. The reference teaches that the increased exercise is useful in reducing body weight and treating obesity. The reference specifically discusses consumption of the claimed composition by individuals wishing to lose weight (see column 1 and Example 2). Thus, US '544 is properly combinable with the other three references.

Applicant also argues that the references do not teach using Guarana PE 22% in the amounts claimed. However, the amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

9. Claims 1-7 are rejected. Claims 15-19 are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 9:30 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.

Susan D. Coe
7-8-05

Susan D. Coe
Primary Examiner
Art Unit 1655